

## **REMARKS**

Applicants respectfully request reconsideration of the subject application.

### **Status of Claims**

Claims 1 through 20 were pending in this application.

Claims 1 through 20 stand rejected by the Examiner.

### **Claim Rejection Under 35 U.S.C. § 101**

The rejection of claim 8 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter is respectfully traversed. Claim 8 is amended to recite “[a] medium storing computer executable software code to perform a method for automatically identifying a counter party position for a short or long position,” with the method comprising steps analogous to those recited in claim 1. No new matter is presented. Applicants reserve the right to present original claim 8 in a continuation or divisional application.

As amended, claim 8 recites statutory subject matter and, therefore, Applicants respectfully request reconsideration and withdrawal of the Section 101 rejection.

### **Claim Rejections Under 35 U.S.C. § 102**

The rejection of claims 1-2, 4, 7-10, and 12-13 under 35 U.S.C. § 102(e) as being anticipated by United States Application Publication No. 2001/0037284 to Finkelstein et al. is respectfully traversed.

In response to Applicants' previous remarks, the Examiner states that "Finkelstein discloses an array of automated trading systems through the background which provide for the exchange of sufficient information to allow a transaction." (July 9, 2007 Office Action at 14.) Even if that is so, such a generalized disclosure does not anticipate the method using the particular architecture claimed in the present invention.

Specifically, independent claim 1 recites particular data flow and operations involving a first terminal, a second terminal, and a third terminal. For example, claim 1 includes:

receiving *at a first terminal* at least two short positions;

receiving *at the first terminal* at least two long positions;

identifying *at the first terminal* a selected short position from the at least two short positions and a selected long position from the at least two long positions, the selected short position and the selected long position identified by parameters associated with the positions; and

providing sufficient information *from the first terminal to a second terminal and to a third terminal* to allow a transaction between the selected short position and the selected long position.

[Emphasis added.]

In contrast to these explicit claim recitations, the Examiner does not, and cannot, point to specifics among Finkelstein's "array" of "background" systems that arguably teach the particular structure and operation claimed. For example, regarding the claim language "providing sufficient information from the first terminal to a second terminal and to a third terminal to allow a transaction between the selected short position and the selected long position," the Examiner cites Finkelstein's specification at page 9, paragraph 64 – which describes only a "system" and not any particular terminals – page 11, paragraph 79 – which describes only certain "[k]nown systems" – page 12, paragraph 89 – which describes only "communication between the remote terminals and a matching computer" – and page 13, paragraph 103 – which describes only two

remote terminals that “may communicate with each other . . . optionally with or without involvement of [a] central computer.” Finkelstein simply does not disclose the specifics recited in claim 1 of the present invention.

Claim 1 therefore is not anticipated by Finkelstein. Accordingly, dependent claims 2, 4, and 7 are also not anticipated. And because the limitations in claim 1 concerning first, second, and third terminals are also present in independent claims 8-10, those claims also are not anticipated by Finkelstein.

Similarly, independent claim 12 also claims a method that uses a particular architecture. Claim 12 includes “sending information on the at least two short positions *to a first terminal*” and “receiving sufficient information *from the first terminal* to allow a transaction between a selected short position and a selected long position.” (Emphasis added.) Nowhere does Finkelstein disclose the specifics recited in claim 12. Accordingly, independent claim 12 and dependent claim 13 are also not anticipated.

Applicants therefore respectfully request reconsideration and withdrawal of the Section 102 rejections based upon the Finkelstein reference.

### **Claim Rejections Under 35 USC § 103**

The rejection of claims 5, 14-15, 17-18, and 20 as unpatentable over Finkelstein in view of U.S. Patent No. 7,231,363 to Hughes is respectfully traversed.

As with the other independent claims discussed previously, independent claim 14 includes limitations concerning a particular structure used by the claimed method, including:

receiving *at a first terminal* at least two short positions from one or more short position parties . . .

identifying *at said first terminal* a selected short position . . . ; and

providing sufficient information *from said first terminal* to said third party agent . . . .

[Emphasis added.]

Just as Finkelstein does not disclose this particular structure, neither does Hughes, and thus the combination of those references cannot render claim 14 unpatentable. Dependent claim 15 therefore also distinguishes over Finkelstein and Hughes.

The rejection of claims 6 and 11 as unpatentable over Finkelstein, and further in view of U.S. Application Publication No. 2002/0095362 to Masand et al., is also respectfully traversed. Dependent claim 6 and independent claim 11 include the limitations concerning first, second, and third terminals that are absent from Finkelstein, and that are also absent from Masand. Nothing indicates that the particular architecture used in the methods of claims 6 and 11 would be obvious in view of Finkelstein alone or in combination with Masand, and therefore claims 6 and 11 distinguish over the cited references.

The rejection of claim 16 as unpatentable over Finkelstein and Hughes, and further in view of U.S. Patent No. 7,107,229 to Sullivan, and the rejection of claim 19 as unpatentable over Finkelstein in view of Hughes, and further in view of Masand, are also respectfully traversed. Claims 16 and 19 both ultimately depend from claim 14, and are therefore patentable over the cited references for at least the same reasons.

Given the defects in Finkelstein and the secondary references discussed above, Applicants decline at this time to address further deficiencies.

Applicants therefore respectfully request reconsideration and withdrawal of the Section 103 rejections based upon the cited references.

### **Request for Reconsideration**

In view of the foregoing, Applicants respectfully request that the Examiner reconsider the rejections of the claims now pending and permit the subject application to proceed to allowance.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited references which have yet to be raised, but which may be raised in the future. Furthermore, Applicants do not concede that the cited references were filed before Applicants' invention.

### **CONCLUSION**

Applicants believe that all outstanding grounds raised by the Examiner have been addressed and respectfully submit that the present application is in condition for allowance, early notification of which is earnestly solicited.

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The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment related to this submission to Deposit Account Number 50-0979.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven I. Wallach", is written over a horizontal line.

Steven I. Wallach.  
Registration No. 35,402

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**DILWORTH PAXSON LLP**  
3200 Mellon Bank Center  
1735 Market Street  
Philadelphia, PA 19103-7595  
Tel. (215) 575-7000  
Fax (215) 575-7200

Attorneys for Applicants